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09/910,510	07/19/2001	Michael L. Obradovich	56023/DMC/C685	9704

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CHRISTIE PARKER & HALE, LLP
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RECEIVED

MAR 28 2008

Christie, Parker & Hale, LLP

CASE # 56023 ACTION Final Rejection
REMINDER 6/26/08 DUE DATE 6/26/08
DEADLINE 7/26/08

EXAMINER

BAYARD, DJENANE M

ART UNIT	PAPER NUMBER
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2141

MAIL DATE	DELIVERY MODE
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03/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/910,510	Applicant(s) OBRADOVICH ET AL.	
	Examiner DJENANE M. BAYARD	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 26-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 26-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to communication filed on 2/12/08 in which claims 1-5 and 26-100 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As per claims 1 and 33, contrary to Applicant's argument, Arlein et al teaches wherein: collecting requested information from one or more sources based on the received data". Furthermore Arlein et al teaches wherein data indicative of a selected one of the profiles (See page 4, paragraph [0044]). Arlein fails to teach wherein the data indicative is of a location of the communication device determined by the communication device. The prior art of Alumbaugh was used to teach a directory function within the travel guide device of the present invention. The travel guide device database may include a directory of locations (including GPS coordinates) for a number of places such as: hotels and other places of lodging; restaurants and other places to eat; points of interest; medical facilities, pharmacies, and the like; and other subscribing locations. The directory entry may include enterprise names, addresses and

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telephone numbers, World Wide Web and/or e-mail addresses, GPS coordinates, and brief descriptions. The directory may be maintained manually and/or updated automatically over the communications facilities of the travel guide device. For example, cellular communications service providers within a given area may automatically establish a communications link to the travel guide device as it enters a defined service area and transmit a local directory to the travel guide device. (See col. 10, lines 15-40).

As per claims 48, 60, 72, 79 86 and 94, Applicant argues that Arlein in view of Alumbaugh fails to teach “information concerning at least first product or service in accordance with the selected profile, wherein the first product or service provider and at least a second product or service provider are selected in a vicinity of the location of the communication device. However, Alumbaugh clearly teaches wherein a directory function within the travel guide device of the present invention. The travel guide device database may include a directory of locations (including GPS coordinates) for a number of places such as: hotels and other places of lodging; restaurants and other places to eat; points of interest; medical facilities, pharmacies, and the like; and other subscribing locations. The directory entry may include enterprise names, addresses and telephone numbers, World Wide Web and/or e-mail addresses, GPS coordinates, and brief descriptions. The directory may be maintained manually and/or updated automatically over the communications facilities of the travel guide device. For example, cellular communications service providers within a given area may automatically establish a communications link to the travel guide device as it enters a defined service area and transmit a local directory to the travel guide device (See col. 10, lines 15-40).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-5 and 26-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2002/0133500 to Arlein et al in view of U.S. Patent No. 6,266,614 to Alumbaugh.

a. As per claims 1 and 33, Arlein et al teaches a method for use in a server serving a user of a communication device, the method comprising: maintaining a plurality of profiles of the user (See page 3, paragraph [0029]); receiving, through a communication network a request for information concerning one or more product or service providers, (See page 3, paragraph [0032], page 4, paragraph [0044]); collecting requested information from one or more sources

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based on the received data; and providing the requested information to the communication device (See page 3, paragraph [0029] and page 4, paragraph [0039]). Furthermore, Arlein et al teaches receiving data indicative of a selected one of the profiles (See page 4, paragraph [0044]). However, Arlein et al fails to teach receiving data indicative of a location of the communication device determined by the communication device; the requested information including information concerning at least one product or service provider, selected in a vicinity of the location communication device in accordance with the selected profile; and providing data for the communication device to indicate to the user a location of the at least one resource relative to the location of the communication device.

Alumbaugh teaches a travel guide that includes a GPS receiver for determining a present location. Furthermore, Alumbaugh teaches receiving data indicative of a location of the communication device determined by the communication device (See col. 10, lines 15-30); the requested information including information concerning at least one product or service provider, selected in a vicinity of the location communication device in accordance with the selected profile (See Col. 10, lines 15-40); and providing data for the communication device to indicate to the user a location of the at least one resource relative to the location of the communication device (See col. 10, lines 15-40).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Arlein et al and the system which utilizes the GPS coordinates of a present location to coordinate the provision of entertainment information (See col. 1, lines 37-39) taught by Alumbaugh to achieve the predictable result of providing requested information to the communication device wherein the requested information including

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information concerning at least one product or service provider selected in a vicinity of the location of the communication device in accordance with a selected profile.

b. As per claims 2 and 34, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. Furthermore, Arlein et al teaches wherein the profiles include a personal profile (See page 3, paragraph [0032]).

c. As per claims 3 and 35, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. Furthermore, Arlein et al teaches wherein the profiles include a business profile (See page 3, paragraph [0032]).

d. As per claims 4 and 36, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. Furthermore, Arlein et al teaches wherein the profiles include a vacation profile (See page 3, paragraph [0032]).

e. As per claims 5 and 37, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. Furthermore, Arlein et al teaches wherein the one or more sources are connected to the Internet (See page 1, paragraph [0003]).

f. As per claims 26 and 38, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. Furthermore, Arlein et al teaches wherein the personal profile

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includes a medical record, at least part of the collected information comprising personal medical information being stored in the medical record (See page 3, paragraph [0032]).

g. As per claims 27 and 39, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. Furthermore, Arlein et al teaches wherein one of the profiles includes a financial record, at least part of the collected information comprising financial information being stored in the financial record (See page 3, paragraph [0032]).

h. As per claim 28 and 40, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. Furthermore, Arlein et al teaches wherein the collected information is stored for the user based on a location of the at least one product or service provider (See page 5, paragraphs [0047-049]).

i. As per claim 29 and 41, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. Furthermore, Arlein et al teaches wherein the collected information is stored in the profile based on one or more types of product or service provided by the at least one resource (See page 5, paragraph [0047-0049]).

j. As per claims 30-31 and 42-43, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. Furthermore, Arlein et al teaches wherein one of the types of product or service concerns entertainment, restaurants and/or current events (See page 3, paragraph [0032]) and figure 7).

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k. As per claims 32 and 44, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. However, Arlein et al fails to teach wherein location of the communication device is indicated by GPS data.

Alumbaugh et al teaches wherein location of the communication device is indicated by GPS data (See col. 2, lines 25-46).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Alumbaugh in the claimed invention of Arlein et al in order to provide a system which utilizes the GPS coordinates of a present location to coordinate the provision of entertainment information (See col. 1, lines 37-39).

l. As per claim 45, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. However, Arlein et al fails to teaches planning a route to the at least one product or service provider

Alumbaugh teaches planning a route to the at least one product or service provider (See col. 5, lines 19-25).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Alumbaugh in the claimed invention of Arlein et al in order to provide a system which utilizes the GPS coordinates of a present location to coordinate the provision of entertainment information (See col. 1, lines 37-39).

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m. As per claims 46 and 47, Arlein et al in view of Alumbaugh teaches the claimed invention as described above. However, Arlein et al fails to teach wherein one of the types of product or service concerns gas stations.

Alumbaugh teaches wherein one of the types of product or service concerns gas stations (See col. 10, line 39).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Alumbaugh in the claimed invention of Arlein et al in order to provide a system which utilizes the GPS coordinates of a present location to coordinate the provision of entertainment information (See col. 1, lines 37-39).

n. As per claims 48 and 60, Arlein et al teaches a method for use in a server serving a user of a communication device, the method comprising: maintaining a plurality of profiles of the user (See page 3, paragraph [0029]); receiving, through a communications network, a request for information concerning one or more product or service providers (See page 3, paragraph [0032] and page 4, paragraph [0044]), collecting requested information from one or more sources based on the data; providing the requested information to the communication device (See page 3, paragraph [0029] and page 4, paragraph [0049]). Furthermore, Arlein et al teaches receiving data indicative of a selected one of the profiles (See page 4, paragraph [0044]). However, Arlein et al fails to teach data indicative of a location of the communication device determined by the communication device; the requested information including information concerning at least a first product or service provider in accordance with the selected profile, wherein the first product or service provider and at least a second product or service provider are selected in a vicinity of

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the location of the communication device; and providing data for the communication device to indicate to the user that the first product or service provider satisfies the selected profile and the second product or service provider does not satisfy the selected profile.

Alumbaugh et al teaches data indicative of a location of the communication device determined by the communication device; the requested information including information concerning at least a first product or service provider in accordance with the selected profile, wherein the first product or service provider and at least a second product or service provider are selected in a vicinity of the location of the communication device; and providing data for the communication device to indicate to the user that the first product or service provider satisfies the selected profile and the second product or service provider does not satisfy the selected profile (See col. 10, lines 15-40).

o. As per claims 49-59 and 61-71, see claims 2-5, 26-32 and 45-46 above.

p. As per claim 72, Arlein et al teaches a method for use in a server serving a user of a communication device, the method comprising: receiving, through a communications network, a request for information concerning one or more product or service providers satisfying at least one user criterion (See page 3, paragraph [0029]), collecting requested information from one or more sources based on the received data; and providing the requested information to the communication device (See page 3, paragraph [0029] and page 4, paragraph [0032-0039]). Furthermore, Arlein et al teaches receiving data indicative of a selected one of the profiles (See page 4, paragraph [0044]). However, Arlein et al fails to teach data indicative of a location of the

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communication device determined by the communication device; the requested information including selected information concerning a plurality of product or service providers satisfying the at least one user criterion, and respective directions and distances thereof from the location of the communication device, the selected information being formatted for the communication device to show the plurality of product or service providers on a list, wherein the list of product or service providers being sortable on their direction and distance from the location of the communication device.

Alumbaugh et al teaches data indicative of a location of the communication device determined by the communication device; the requested information including selected information concerning a plurality of product or service providers satisfying the at least one user criterion, and respective directions and distances thereof from the location of the communication device, the selected information being formatted for the communication device to show the plurality of product or service providers on a list, wherein the list of product or service providers is sortable on their direction and distance from the location of the communication device (See col. 10, lines 15-40).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Arlein et al and the system which utilizes the GPS coordinates of a present location to coordinate the provision of entertainment information (See col. 1, lines 37-39) taught by Alumbaugh to achieve the predictable result of providing requested information to the communication device wherein the requested information including information concerning at least one product or service provider selected in a vicinity of the location of the communication device in accordance with a selected profile.

q. As per claims 73-78, see claims 2-5, 26-32 and 45-46

r. As per claim 79, Arlein et al teaches a system for serving a user of a communication device, the system comprising: an interface for receiving, through a communications network, a request for information concerning one or more product or service providers satisfying at least one user criterion (See page 3, paragraph [0029]) and an output element for providing the requested information to the communication device, the requested information including selected information concerning a plurality of product or service providers satisfying the at least one user criterion (See page 3, paragraph [0029] and page 4, paragraph [0032-0039]). Furthermore, Arlein et al teaches receiving data indicative of a selected one of the profiles (See page 4, paragraph [0044]). However, Arlein et al fails to teach and data indicative of a location of the communication device determined by the communication device; a processing unit configured to collect requested information from one or more sources based on the received data; and respective directions and distances thereof from the location of the communication device, the selected information being formatted for the communication device to show the plurality of product or service providers on a list, wherein the list of product or service providers being storable on their direction and distance from the location of the communication device (See col. 10, lines 15-40).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Arlein et al and the system which utilizes the GPS coordinates of a present location to coordinate the provision of entertainment information (See

col. 1, lines 37-39) taught by Alumbaugh to achieve the predictable result of providing requested information to the communication device wherein the requested information including information concerning at least one product or service provider selected in a vicinity of the location of the communication device in accordance with a selected profile.

s. As per claims 80-85, see claims 2-5, 26-32 and 45-46.

t. As per claims 86 and 94, Arlein et al teaches a method for use in a server serving a user of a communication device, the method comprising: receiving, through a communications network, a request for information concerning one or more product or service providers satisfying at least one user criterion (See page 3, paragraph [0029]) and collecting requested information from one or more sources based on the received data; and providing the requested information to the communication device (See page 3, paragraph [0029] and page 4, paragraph [0032-0039]). Furthermore, Arlein et al teaches receiving data indicative of a selected one of the profiles (See page 4, paragraph [0044]). However, Arlein et al fails to teach data indicative of a location of the communication device determined by the communication device; the requested information including information concerning at least one product or service provider, and an operating status thereof, the at least one product or service provider being selected in a vicinity of the location of the communication device and in accordance with the at least one user criterion, wherein the operating status indicates whether the at least one product or service provider is open for business (See col. 10, lines 15-40).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Arlein et al and the system which utilizes the GPS coordinates of a present location to coordinate the provision of entertainment information (See col. 1, lines 37-39) taught by Alumbaugh to achieve the predictable result of providing requested information to the communication device wherein the requested information including information concerning at least one product or service provider selected in a vicinity of the location of the communication device in accordance with a selected profile.

- u. As per claim 87-93 and 95-100, see claims 2-5, 26-32 and 45-46 above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Djenane Bayard

Patent Examiner

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2144

LEXSEE 127 S.CT. 1727

KSR INTERNATIONAL CO., Petitioner v. TELEFLEX INC. et al.

No. 04-1350

SUPREME COURT OF THE UNITED STATES

127 S. Ct. 1727; 167 L. Ed. 2d 705; 2007 U.S. LEXIS 4745; 75 U.S.L.W. 4289; 82
U.S.P.Q.2D (BNA) 1385; 20 Fla. L. Weekly Fed. S 248

November 28, 2006, Argued
April 30, 2007, Decided

NOTICE:

[**1] The LEXIS pagination of this document is subject to change pending release of the final published version.

SUBSEQUENT HISTORY: On remand at *Teleflex, Inc. v. KSR Int'l Co.*, 228 Fed. Appx. 988, 2007 U.S. App. LEXIS 16051 (Fed. Cir., June 20, 2007)

PRIOR HISTORY: ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT.

Teleflex, Inc. v. KSR Int'l Co., 119 Fed. Appx. 282, 2005 U.S. App. LEXIS 176 (Fed. Cir., 2005)

DISPOSITION: Reversed and remanded.

DECISION:

[**705] Company that added modular sensor to its automobile-accelerator-pedal system held entitled to summary judgment in infringement action by holder of license for patent covering assembly with electronic sensor, as pertinent claim was "obvious" within meaning of 35 U.S.C.S. § 103.

SUMMARY:

Procedural posture: Respondent, licensees of a patent, alleged that petitioner, a competitor, infringed the licensees' patent for an accelerator pedal assembly for vehicles, but the competitor asserted that the patent claim in dispute was invalid as obvious under 35 U.S.C.S. § 103. Upon the grant of a writ of certiorari, the competitor appealed the judgment of the U.S. Court of Appeals for the Federal Circuit which reversed a summary judgment of patent invalidity.

Overview: To satisfy customer needs, the competitor modified its design for an adjustable pedal system for vehicles with cable-actuated throttles by adding a modular sensor to make the system compatible with vehicles using computer-controlled throttles. The licensees contended that the competitor infringed the patent claim of a position-adjustable pedal assembly with an electronic pedal position sensor attached a fixed pivot point. The U.S. Supreme Court unanimously held that the patent claim was invalid as obvious since mounting an available sensor on a fixed pivot point of the competitor's pedal was a design step well within the grasp of a person of ordinary skill in the relevant art, and the benefit of doing so was obvious. The marketplace created a strong incentive to convert mechanical pedals to electronic pedals, and the prior art taught a number of methods for doing so. Further, the problem to be solved by the patent claim did not limit its application as prior art, the competitor's showing that it was obvious to try a combination of elements [**706] sufficiently supported the finding of obviousness, and the claim was the result of ordinary skill and common sense rather than innovation.

Outcome: The judgment reversing the summary judgment of invalidity was reversed, and the case was remanded for further proceedings.

LAWYERS' EDITION HEADNOTES:

[**LEdHN1]

PATENTS § 19.1

PATENTABILITY -- OBVIOUSNESS OF SUBJECT MATTER

Headnote:[1]

35 U.S.C.S. § 103 forbids issuance of a patent when the differences between the subject matter sought to be patented and the prior art are such that the subject matter

127 S. Ct. 1727, *; 167 L. Ed. 2d 705, **;
2007 U.S. LEXIS 4745, ***; 75 U.S.L.W. 4289

as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

[**LEdHN2]

PATENTS § 19 PATENTS § 19.1

PATENTABILITY -- MECHANICAL SKILL --
OBVIOUSNESS OF SUBJECT MATTER

Headnote:[2]

Under 35 U.S.C.S. § 103, the scope and content of prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103.

[**LEdHN3]

EVIDENCE § 333

PATENT -- PRESUMPTION OF VALIDITY

Headnote:[3]

By direction of 35 U.S.C.S. § 282, an issued patent is presumed valid.

[**LEdHN4]

PATENTS § 37

PATENTABILITY -- COMBINATION OF OLD
ELEMENTS

Headnote:[4]

A patent for a combination which only unites old elements with no change in their respective functions obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men. This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

[**LEdHN5]

PATENTS § 50

PATENTABILITY -- OBVIOUSNESS OF IM-
PROVEMENT

Headnote:[5]

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, 35 U.S.C.S. § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. A court must ask whether the [**707] improvement is more than the predictable use of prior art elements according to their established functions.

[**LEdHN6]

PATENTS § 19.1

PATENTABILITY -- OBVIOUSNESS OF SUB-
JECT MATTER

Headnote:[6]

Rejection of a patent on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support a legal conclusion of obviousness. However, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

[**LEdHN7]

PATENTS § 19.1

PATENTABILITY -- COMPOSITION OF ELE-
MENTS -- OBVIOUSNESS

Headnote:[7]

A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building

blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

[**LEdHN8]

PATENTS § 19.1

PATENTABILITY -- OBVIOUSNESS OF TECHNIQUES OR COMBINATIONS -- SCIENTIFIC LITERATURE

Headnote:[8]

The obviousness analysis in the patent context cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.

[**LEdHN9]

PATENTS § 19.1

PATENTABILITY -- SUBJECT MATTER -- DETERMINATION WHETHER OBVIOUS

Headnote:[9]

In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under *35 U.S.C.S. § 103*. One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

[**LEdHN10]

PATENTS § 19.1

PATENTABILITY -- OBVIOUSNESS

Headnote:[10]

A problem motivating a patentee may be only one of many addressed by the patent's subject matter. The question is not whether the combination was obvious to the

patentee [**708] but whether the combination was obvious to a person with ordinary skill in the art.

[**LEdHN11]

PATENTS § 19 PATENTS § 19.1

PATENTABILITY -- ORDINARY SKILL -- OBVIOUSNESS

Headnote:[11]

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under *35 U.S.C.S. § 103*.

[**LEdHN12]

PATENTS § 19.1

PATENTABILITY -- OBVIOUSNESS

Headnote:[12]

In a patent obviousness case, a factfinder must be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under U.S. Supreme Court case law nor consistent with it.

[**LEdHN13]

SUMMARY JUDGMENT AND JUDGMENT ON PLEADINGS § 5

PATENTABILITY -- OBVIOUSNESS OF CLAIM -- SUMMARY JUDGMENT

Headnote:[13]

In considering summary judgment on a question of patent obviousness, a district court can and should take into account expert testimony, which may resolve or keep open certain questions of fact. That is not the end of the issue, however. The ultimate judgment of obviousness is a legal determination. Where the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors, summary judgment is appropriate.

[**LEdHN14]

PATENTS § 17 PATENTS § 19.1

PATENTABILITY -- ORDINARY INNOVATION
-- OBVIOUS SUBJECT MATTER

Headnote:[14]

As progress beginning from higher levels of achievement is expected in the normal course, the results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. *U.S. Const. art. I, § 8, cl. 8*. These premises lead to the bar on patents claiming obvious subject matter established by case law and codified in *35 U.S.C.S. § 103*. Application of the bar must not be confined within a test or formulation too constrained to serve its purpose.

SYLLABUS

[**709] To control a conventional automobile's speed, the driver depresses or releases the gas pedal, which interacts with the throttle via a cable or other mechanical link. Because the pedal's position in the footwell normally cannot be adjusted, a driver wishing to be closer or farther from it must either reposition himself in the seat or move the seat, both of which can be imperfect solutions for smaller drivers in cars with deep footwells. This prompted inventors to design and patent pedals that could be adjusted to change their locations. The Asano patent reveals a support structure whereby, when the pedal location is [***2] adjusted, one of the pedal's pivot points stays fixed. Asano is also designed so that the force necessary to depress the pedal is the same regardless of location adjustments. The Redding patent reveals a different, sliding mechanism where both the pedal and the pivot point are adjusted.

In newer cars, computer-controlled throttles do not operate through force transferred from the pedal by a mechanical link, but open and close valves in response to electronic signals. For the computer to know what is happening with the pedal, an electronic sensor must translate the mechanical operation into digital data. Inventors had obtained a number of patents for such sensors. The so-called '936 *patent* taught that it was preferable to detect the pedal's position in the pedal mechanism, not in the engine, so the patent disclosed a pedal with an electronic sensor on a pivot point in the pedal assembly. The Smith patent taught that to prevent the wires connecting the sensor to the computer from chafing and wearing out, the sensor should be put on a fixed part of the pedal assembly rather than in or on the pedal's footpad. Inventors had also patented self-contained modular sensors, which can be [***3] taken off the shelf and attached to any mechanical pedal to allow it to function with a computer-controlled throttle. The '068 *patent* disclosed one such sensor. Chevrolet also manufactured trucks using modular sensors attached to the pedal sup-

port bracket, adjacent to the pedal and engaged [**710] with the pivot shaft about which the pedal rotates. Other patents disclose electronic sensors attached to adjustable pedal assemblies. For example, the Rixon patent locates the sensor in the pedal footpad, but is known for wire chafing.

After petitioner KSR developed an adjustable pedal system for cars with cable-actuated throttles and obtained its '976 *patent* for the design, General Motors Corporation (GMC) chose KSR to supply adjustable pedal systems for trucks using computer-controlled throttles. To make the '976 pedal compatible with the trucks, KSR added a modular sensor to its design. Respondents (Teleflex) hold the exclusive license for the Engelgau patent, claim 4 of which discloses a position-adjustable pedal assembly with an electronic pedal position sensor attached a fixed pivot point. Despite having denied a similar, broader claim, the U. S. Patent and Trademark Office (PTO) had allowed [***4] claim 4 because it included the limitation of a fixed pivot position, which distinguished the design from Redding's. Asano was neither included among the Engelgau patent's prior art references nor mentioned in the patent's prosecution, and the PTO did not have before it an adjustable pedal with a fixed pivot point. After learning of KSR's design for GMC, Teleflex sued for infringement, asserting that KSR's pedal system infringed the Engelgau patent's claim 4. KSR countered that claim 4 was invalid under § 103 of the Patent Act, which forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art."

Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545, set out an objective analysis for applying § 103: "[T]he scope and content of the prior art are . . . determined; differences between the prior art and the claims at issue are . . . ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness [***5] of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." While the sequence of these questions might be reordered in any particular case, the factors define the controlling inquiry. However, seeking to resolve the obviousness question with more uniformity and consistency, the Federal Circuit has employed a "teaching, suggestion, or motivation" (TSM) test, under which a patent claim is only proved obvious if the prior art, the problem's nature, or the knowledge of a person having

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ordinary skill in the art reveals some motivation or suggestion to combine the prior art teachings.

The District Court granted KSR summary judgment. After reviewing pedal design history, the Engelgau patent's scope, and the relevant prior art, the court considered claim 4's validity, applying *Graham's* framework to determine whether under summary-judgment standards KSR had demonstrated that claim 4 was obvious. The court found "little difference" between the prior art's teachings and claim 4: [***6] Asano taught everything contained in the claim except [**711] using a sensor to detect the pedal's position and transmit it to a computer controlling the throttle. That additional aspect was revealed in, e.g., the '068 patent and Chevrolet's sensors. The court then held that KSR satisfied the TSM test, reasoning (1) the state of the industry would lead inevitably to combinations of electronic sensors and adjustable pedals, (2) Rixon provided the basis for these developments, and (3) Smith taught a solution to Rixon's chafing problems by positioning the sensor on the pedal's fixed structure, which could lead to the combination of a pedal like Asano with a pedal position sensor.

Reversing, the Federal Circuit ruled the District Court had not applied the TSM test strictly enough, having failed to make findings as to the specific understanding or principle within a skilled artisan's knowledge that would have motivated one with no knowledge of the invention to attach an electronic control to the Asano assembly's support bracket. The Court of Appeals held that the District Court's recourse to the nature of the problem to be solved was insufficient because, unless the prior art references [***7] addressed the precise problem that the patentee was trying to solve, the problem would not motivate an inventor to look at those references. The appeals court found that the Asano pedal was designed to ensure that the force required to depress the pedal is the same no matter how the pedal is adjusted, whereas Engelgau sought to provide a simpler, smaller, cheaper adjustable electronic pedal. The Rixon pedal, said the court, suffered from chafing but was not designed to solve that problem and taught nothing helpful to Engelgau's purpose. Smith, in turn, did not relate to adjustable pedals and did not necessarily go to the issue of motivation to attach the electronic control on the pedal assembly's support bracket. So interpreted, the court held, the patents would not have led a person of ordinary skill to put a sensor on an Asano-like pedal. That it might have been obvious to try that combination was likewise irrelevant. Finally, the court held that genuine issues of material fact precluded summary judgment.

Held:

The Federal Circuit addressed the obviousness question in a narrow, rigid manner that is inconsistent with §

103 and this Court's precedents. KSR provided convincing [***8] evidence that mounting an available sensor on a fixed pivot point of the Asano pedal was a design step well within the grasp of a person of ordinary skill in the relevant art and that the benefit of doing so would be obvious. Its arguments, and the record, demonstrate that the Engelgau patent's claim 4 is obvious. Pp. 11-24.

1. *Graham* provided an expansive and flexible approach to the obviousness question that is inconsistent with the way the Federal Circuit applied its TSM test here. Neither § 103's enactment nor *Graham's* analysis disturbed the Court's earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art. See *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 71 S. Ct. 127, 95 L. Ed. 162, 1951 Dec. Comm'r Pat. 572 Such a combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. See, e.g., *United States v. Adams*, 383 U.S. 39, 50-52, 86 S. Ct. 708, 15 L. Ed. 2d 572, 174 Ct. Cl. 1293 When a work is available in one field, design incentives and other market forces [**712] can prompt variations of it, either in the same field or in another. If a person [***9] of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. A court must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions. Following these principles may be difficult if the claimed subject matter involves more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement. To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should [***10] be made explicit. But it need not seek out precise teachings directed to the challenged claim's specific subject matter, for a court can consider the inferences and creative steps a person of ordinary skill in the art would employ. Pp. 11-14.

(b) The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, inde-

pendently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does. Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known. Helpful insights, however, need not become rigid and mandatory formulas. If it is so applied, the TSM test is incompatible with this Court's precedents. The diversity of inventive pursuits and of modern technology counsels against confining the obviousness analysis [***11] by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasizing the importance of published articles and the explicit content of issued patents. In many fields there may be little discussion of obvious techniques or combinations, and market demand, rather than scientific literature, may often drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, for patents combining previously known elements, deprive prior inventions of their value or utility. Since the TSM test was devised, the Federal Circuit doubtless has applied it in accord with these principles in many cases. There is no necessary inconsistency between the test and the *Graham* analysis. But a court errs where, as here, it transforms general principle into a rigid rule limiting the obviousness inquiry. Pp. 14-15.

(c) The flaws in the Federal Circuit's analysis relate mostly to its [**713] narrow conception of the obviousness inquiry consequent in its application of the TSM test. The Circuit first erred in holding that courts and patent examiners should look only to the problem the patentee was trying [***12] to solve. Under the correct analysis, any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed. Second, the appeals court erred in assuming that a person of ordinary skill in the art attempting to solve a problem will be led only to those prior art elements designed to solve the same problem. The court wrongly concluded that because Asano's primary purpose was solving the constant ratio problem, an inventor considering how to put a sensor on an adjustable pedal would have no reason to consider putting it on the Asano pedal. It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle. Regardless of Asano's primary purpose, it provided an obvious example of an adjustable pedal with a fixed pivot point, and the prior art was replete with patents indicating that such a point was

an ideal mount for a sensor. Third, the court erred in concluding that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try. [***13] When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. Finally, the court drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias. Rigid preventative rules that deny recourse to common sense are neither necessary under, nor consistent with, this Court's case law. Pp. 15-18.

2. Application of the foregoing standards demonstrates that claim 4 is obvious. Pp. 18-23.

(a) The Court rejects Teleflex's argument that the Asano pivot mechanism's design prevents its combination with a sensor in the manner claim 4 describes. This argument was not raised before the District Court, and it is unclear whether it was raised before the Federal Circuit. Given the significance of the District Court's finding that combining Asano with a pivot-mounted pedal position sensor fell within claim 4's scope, it is apparent that Teleflex would [***14] have made clearer challenges if it intended to preserve this claim. Its failure to clearly raise the argument, and the appeals court's silence on the issue, lead this Court to accept the District Court's conclusion. Pp. 18-20.

(b) The District Court correctly concluded that when Engelgau designed the claim 4 subject matter, it was obvious to a person of ordinary skill in the art to combine Asano with a pivot-mounted pedal position sensor. There then was a marketplace creating a strong incentive to convert mechanical pedals to electronic pedals, and the prior art taught a number of methods for doing so. The Federal Circuit considered the issue too narrowly by, in effect, asking whether a pedal designer writing on a blank slate would have chosen both Asano and a modular sensor similar to the ones used in the Chevrolet trucks and [**714] disclosed in the '068 patent. The proper question was whether a pedal designer of ordinary skill in the art, facing the wide range of needs created by developments in the field, would have seen an obvious benefit to upgrading Asano with a sensor. For such a designer starting with Asano, the question was where to attach the sensor. The '936 patent taught [***15] the utility of putting the sensor on the pedal device. Smith, in turn, explained not to put the sensor on the pedal footpad, but instead on the structure. And from Rixon's known wire-chafing problems, and Smith's teaching that the pedal assemblies must not precipitate any motion in the connecting wires, the designer would know to place

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the sensor on a nonmoving part of the pedal structure. The most obvious such point is a pivot point. The designer, accordingly, would follow Smith in mounting the sensor there. Just as it was possible to begin with the objective to upgrade Asano to work with a computer-controlled throttle, so too was it possible to take an adjustable electronic pedal like Rixon and seek an improvement that would avoid the wire-chafing problem. Teleflex has not shown anything in the prior art that taught away from the use of Asano, nor any secondary factors to dislodge the determination that claim 4 is obvious. Pp. 20-23.

3. The Court disagrees with the Federal Circuit's holding that genuine issues of material fact precluded summary judgment. The ultimate judgment of obviousness is a legal determination. *Graham*, 383 U.S., at 17, 86 S. Ct. 684, 15 L. Ed. 2d 545. Where, as here, the [***16] prior art's content, the patent claim's scope, and the level of ordinary skill in the art are not in material dispute and the claim's obviousness is apparent, summary judgment is appropriate. P. 23.

119 Fed. Appx. 282, reversed and remanded.

COUNSEL: James W. Dabney argued the cause for petitioner.

Thomas G. Hungar argued the cause for the United States, as amicus curiae, by special leave of court.

Thomas C. Goldstein argued the cause for respondents.

JUDGES: Kennedy, J., delivered the opinion for a unanimous Court.

OPINION BY: KENNEDY

OPINION

[*1734] Justice **Kennedy** delivered the opinion of the Court.

Teleflex Incorporated and its subsidiary Technology Holding Company--both referred to here as Teleflex--sued KSR International Company for patent infringement. The patent at issue, *United States Patent No. 6,237,565 B1*, is entitled "Adjustable Pedal Assembly With Electronic Throttle Control." Supplemental App. 1. The patentee is Steven J. Engelgau, and the patent is referred to as "the Engelgau patent." Teleflex holds the exclusive license to the patent.

Claim 4 of the Engelgau patent describes a mechanism for combining an electronic sensor with an adjustable automobile pedal so the pedal's position can be transmitted to a computer that controls the throttle in the vehicle's engine. When Teleflex accused KSR of infring-

ing the Engelgau patent by adding an electronic sensor to one of KSR's previously [***17] designed pedals, KSR countered that claim 4 was invalid under the Patent Act, 35 U.S.C. § 103, because its subject matter was obvious.

[**LEdHR1] [1]Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having [**715] ordinary skill in the art to which said subject matter pertains."

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966), the Court set out a framework for applying the statutory language of § 103, language itself based on the logic of the earlier decision in *Hotchkiss v. Greenwood*, 52 U.S. 248, 11 How. 248, 13 L. Ed. 683 (1851), and its progeny. See 383 U.S., at 15-17, 86 S. Ct. 684, 15 L. Ed. 2d 545. The analysis is objective:

[**LEdHR2] [2]"Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations [***18] as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Id.*, at 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545.

While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103.

Seeking to resolve the question of obviousness with more uniformity and consistency, the Court of Appeals for the Federal Circuit has employed an approach referred to by the parties as the "teaching, suggestion, or motivation" test (TSM test), under which a patent claim is only proved obvious if "some motivation or suggestion to combine the prior art teachings" can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art. See, e.g., *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1323-1324 (CA

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Fed. 1999). KSR challenges that [*1735] test, or at least its application in this case. See *119 Fed. Appx. 282, 286-290 (CA Fed. 2005)*. [***19] Because the Court of Appeals addressed the question of obviousness in a manner contrary to § 103 and our precedents, we granted certiorari, *547 U.S. , 126 S. Ct. 2965, 165 L. Ed. 2d 949 (2006)*. We now reverse.

I

A

In car engines without computer-controlled throttles, the accelerator pedal interacts with the throttle via cable or other mechanical link. The pedal arm acts as a lever rotating around a pivot point. In a cable-actuated throttle control the rotation caused by pushing down the pedal pulls a cable, which in turn pulls open valves in the carburetor or fuel injection unit. The wider the valves open, the more fuel and air are released, causing combustion to increase and the car to accelerate. When the driver takes his foot off the pedal, the opposite occurs as the cable is released and the valves slide closed.

In the 1990's it became more common to install computers in cars to control engine operation. Computer-controlled throttles open and close valves in response to electronic signals, not through force transferred from the pedal by a mechanical link. Constant, delicate adjustments of air and fuel mixture are possible. The computer's rapid processing of factors beyond the pedal's position improves [***20] [**716] fuel efficiency and engine performance.

For a computer-controlled throttle to respond to a driver's operation of the car, the computer must know what is happening with the pedal. A cable or mechanical link does not suffice for this purpose; at some point, an electronic sensor is necessary to translate the mechanical operation into digital data the computer can understand.

Before discussing sensors further we turn to the mechanical design of the pedal itself. In the traditional design a pedal can be pushed down or released but cannot have its position in the footwell adjusted by sliding the pedal forward or back. As a result, a driver who wishes to be closer or farther from the pedal must either reposition himself in the driver's seat or move the seat in some way. In cars with deep footwells these are imperfect solutions for drivers of smaller stature. To solve the problem, inventors, beginning in the 1970's, designed pedals that could be adjusted to change their location in the footwell. Important for this case are two adjustable pedals disclosed in *U.S. Patent Nos. 5,010,782* (filed July 28, 1989) (Asano) and *5,460,061* (filed Sept. 17, 1993) (Redding). The Asano patent reveals a [***21] support structure that houses the pedal so that even when the pedal location is adjusted relative to the driver, one of the

pedal's pivot points stays fixed. The pedal is also designed so that the force necessary to push the pedal down is the same regardless of adjustments to its location. The Redding patent reveals a different, sliding mechanism where both the pedal and the pivot point are adjusted.

We return to sensors. Well before Engelgau applied for his challenged patent, some inventors had obtained patents involving electronic pedal sensors for computer-controlled throttles. These inventions, such as the device disclosed in *U.S. Patent No. 5,241,936* (filed Sept. 9, 1991) ('936), taught that it was preferable to detect the pedal's position in the pedal assembly, not in the engine. The '936 patent disclosed a pedal with an electronic sensor on a pivot point in the pedal assembly. *U.S. Patent No. 5,063,811* (filed July 9, 1990) (Smith) taught that to prevent the [*1736] wires connecting the sensor to the computer from chafing and wearing out, and to avoid grime and damage from the driver's foot, the sensor should be put on a fixed part of the pedal assembly rather than in or on the pedal's [***22] footpad.

In addition to patents for pedals with integrated sensors inventors obtained patents for self-contained modular sensors. A modular sensor is designed independently of a given pedal so that it can be taken off the shelf and attached to mechanical pedals of various sorts, enabling the pedals to be used in automobiles with computer-controlled throttles. One such sensor was disclosed in *U.S. Patent No. 5,385,068* (filed Dec. 18, 1992) ('068). In 1994, Chevrolet manufactured a line of trucks using modular sensors "attached to the pedal support bracket, adjacent to the pedal and engaged with the pivot shaft about which the pedal rotates in operation." *298 F. Supp. 2d 581, 589 (E.D. Mich. 2003)*.

The prior art contained patents involving the placement of sensors on adjustable pedals as well. For example, *U.S. Patent No. 5,819,593* (filed Aug. 17, 1995) (Rixon) discloses an adjustable pedal assembly with an [**717] electronic sensor for detecting the pedal's position. In the Rixon pedal the sensor is located in the pedal footpad. The Rixon pedal was known to suffer from wire chafing when the pedal was depressed and released.

This short account of pedal and sensor technology leads [***23] to the instant case.

B

KSR, a Canadian company, manufactures and supplies auto parts, including pedal systems. Ford Motor Company hired KSR in 1998 to supply an adjustable pedal system for various lines of automobiles with cable-actuated throttle controls. KSR developed an adjustable mechanical pedal for Ford and obtained *U.S. Patent No. 6,151,976* (filed July 16, 1999) ('976) for the design. In 2000, KSR was chosen by General Motors Corporation

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(GMC or GM) to supply adjustable pedal systems for Chevrolet and GMC light trucks that used engines with computer-controlled throttles. To make the '976 pedal compatible with the trucks, KSR merely took that design and added a modular sensor.

Teleflex is a rival to KSR in the design and manufacture of adjustable pedals. As noted, it is the exclusive licensee of the Engelgau patent. Engelgau filed the patent application on August 22, 2000 as a continuation of a previous application for *U.S. Patent No. 6,109,241*, which was filed on January 26, 1999. He has sworn he invented the patent's subject matter on February 14, 1998. The Engelgau patent discloses an adjustable electronic pedal described in the specification as a "simplified vehicle control [***24] pedal assembly that is less expensive, and which uses fewer parts and is easier to package within the vehicle." Engelgau, col. 2, lines 2-5, Supplemental App. 6. Claim 4 of the patent, at issue here, describes:

"A vehicle control pedal apparatus comprising:

a support adapted to be mounted to a vehicle structure;

an adjustable pedal assembly having a pedal arm moveable in for[e] and aft directions with respect to said support;

a pivot for pivotally supporting said adjustable pedal assembly with respect to said support and defining a pivot axis; and

an electronic control attached to said support for controlling a vehicle system;

said apparatus characterized by said electronic control being responsive to said pivot for providing a signal that corresponds to pedal arm position as said pedal arm pivots about said pivot [*1737] axis between rest and applied positions wherein the position of said pivot remains constant while said pedal arm moves in fore and aft directions with respect to said pivot." *Id.*, col. 6, lines 17-36, Supplemental App. 8 (diagram numbers omitted).

We agree with the District Court that the claim discloses "a position-adjustable pedal [***25] assembly with an electronic pedal position sensor attached to the support member of the pedal assembly. Attaching the sensor to the support member allows the sensor to remain

in a fixed position while the driver adjusts the pedal." 298 F. Supp. 2d, at 586-587.

Before issuing the Engelgau patent the U. S. Patent and Trademark Office (PTO) rejected one of the patent claims that was similar to, but [**718] broader than, the present claim 4. The claim did not include the requirement that the sensor be placed on a fixed pivot point. The PTO concluded the claim was an obvious combination of the prior art disclosed in Redding and Smith, explaining:

"Since the prior ar[t] references are from the field of endeavor, the purpose disclosed . . . would have been recognized in the pertinent art of Redding. Therefore it would have been obvious . . . to provide the device of Redding with the . . . means attached to a support member as taught by Smith." *Id.*, at 595.

In other words Redding provided an example of an adjustable pedal and Smith explained how to mount a sensor on a pedal's support structure, and the rejected patent claim merely put these two teachings together.

[***26] Although the broader claim was rejected, claim 4 was later allowed because it included the limitation of a fixed pivot point, which distinguished the design from Redding's. *Ibid.* Engelgau had not included Asano among the prior art references, and Asano was not mentioned in the patent's prosecution. Thus, the PTO did not have before it an adjustable pedal with a fixed pivot point. The patent issued on May 29, 2001 and was assigned to Teleflex.

Upon learning of KSR's design for GM, Teleflex sent a warning letter informing KSR that its proposal would violate the Engelgau patent. "Teleflex believes that any supplier of a product that combines an adjustable pedal with an electronic throttle control necessarily employs technology covered by one or more" of Teleflex's patents. *Id.*, at 585. KSR refused to enter a royalty arrangement with Teleflex; so Teleflex sued for infringement, asserting KSR's pedal infringed the Engelgau patent and two other patents. *Ibid.* Teleflex later abandoned its claims regarding the other patents and dedicated the patents to the public. The remaining contention was that KSR's pedal system for GM infringed claim 4 of the Engelgau patent. [***27] Teleflex has not argued that the other three claims of the patent are infringed by KSR's pedal, nor has Teleflex argued that the mechanical adjustable pedal designed by KSR for Ford infringed any of its patents.

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The District Court granted summary judgment in KSR's favor. After reviewing the pertinent history of pedal design, the scope of the Engelgau patent, and the relevant prior art, the court considered the validity of the contested claim. [**LEdHR3] [3] By direction of 35 U.S.C. § 282, an issued patent is presumed valid. The District Court applied *Graham's* framework to determine whether under summary-judgment standards KSR had overcome the presumption and demonstrated that claim 4 was obvious in light of the prior art in existence when [*1738] the claimed subject matter was invented. See § 102(a).

The District Court determined, in light of the expert testimony and the parties' stipulations, that the level of ordinary skill in pedal design was "an undergraduate degree in mechanical engineering (or an equivalent amount of industry experience) [and] familiarity with pedal control systems for vehicles." 298 F. Supp. 2d, at 590. The court then set forth the [***28] relevant prior art, including the patents and pedal designs described above.

[**719] Following *Graham's* direction, the court compared the teachings of the prior art to the claims of Engelgau. It found "little difference." 298 F. Supp. 2d, at 590. Asano taught everything contained in claim 4 except the use of a sensor to detect the pedal's position and transmit it to the computer controlling the throttle. That additional aspect was revealed in sources such as the '068 patent and the sensors used by Chevrolet.

Under the controlling cases from the Court of Appeals for the Federal Circuit, however, the District Court was not permitted to stop there. The court was required also to apply the TSM test. The District Court held KSR had satisfied the test. It reasoned (1) the state of the industry would lead inevitably to combinations of electronic sensors and adjustable pedals, (2) Rixon provided the basis for these developments, and (3) Smith taught a solution to the wire chafing problems in Rixon, namely locating the sensor on the fixed structure of the pedal. This could lead to the combination of Asano, or a pedal like it, with a pedal position sensor.

The conclusion that the [***29] Engelgau design was obvious was supported, in the District Court's view, by the PTO's rejection of the broader version of claim 4. Had Engelgau included Asano in his patent application, it reasoned, the PTO would have found claim 4 to be an obvious combination of Asano and Smith, as it had found the broader version an obvious combination of Redding and Smith. As a final matter, the District Court held that the secondary factor of Teleflex's commercial success with pedals based on Engelgau's design did not alter its conclusion. The District Court granted summary judgment for KSR.

With principal reliance on the TSM test, the Court of Appeals reversed. It ruled the District Court had not been strict enough in applying the test, having failed to make "finding[s] as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention' . . . to attach an electronic control to the support bracket of the Asano assembly." 119 Fed. Appx., at 288 (brackets in original) (quoting *In re Kotzab*, 217 F.3d 1365, 1371 (CA Fed. 2000)). The Court of Appeals held that the District Court was [***30] incorrect that the nature of the problem to be solved satisfied this requirement because unless the "prior art references address[ed] the precise problem that the patentee was trying to solve," the problem would not motivate an inventor to look at those references. 119 Fed. Appx., at 288.

Here, the Court of Appeals found, the Asano pedal was designed to solve the "constant ratio problem"--that is, to ensure that the force required to depress the pedal is the same no matter how the pedal is adjusted--whereas Engelgau sought to provide a simpler, smaller, cheaper adjustable electronic pedal. *Ibid.* As for Rixon, the court explained, that pedal suffered from the problem of wire chafing but was not designed to solve it. In the court's view Rixon did not teach anything helpful to Engelgau's purpose. Smith, in turn, did not relate to adjustable pedals and did not "necessarily go to the issue of motivation [*1739] to attach the electronic control on the support bracket of the pedal assembly." *Ibid.* When the patents were interpreted in this way, the Court of Appeals held, they would not have led a person of ordinary skill to put a sensor on the sort of pedal described in Asano.

[**720] [***31] That it might have been obvious to try the combination of Asano and a sensor was likewise irrelevant, in the court's view, because "[o]bvious to try" has long been held not to constitute obviousness." *Id.*, at 289 (quoting *In re Deuel*, 51 F.3d 1552, 1559 (CA Fed. 1995)).

The Court of Appeals also faulted the District Court's consideration of the PTO's rejection of the broader version of claim 4. The District Court's role, the Court of Appeals explained, was not to speculate regarding what the PTO might have done had the Engelgau patent mentioned Asano. Rather, the court held, the District Court was obliged first to presume that the issued patent was valid and then to render its own independent judgment of obviousness based on a review of the prior art. The fact that the PTO had rejected the broader version of claim 4, the Court of Appeals said, had no place in that analysis.

The Court of Appeals further held that genuine issues of material fact precluded summary judgment. Teleflex had proffered statements from one expert that claim

4 "was a simple, elegant, and novel combination of features," 119 Fed. Appx., at 290, compared to Rixon, [***32] and from another expert that claim 4 was non-obvious because, unlike in Rixon, the sensor was mounted on the support bracket rather than the pedal itself. This evidence, the court concluded, sufficed to require a trial.

II

A

We begin by rejecting the rigid approach of the Court of Appeals. Throughout this Court's engagement with the question of obviousness, our cases have set forth an expansive and flexible approach inconsistent with the way the Court of Appeals applied its TSM test here. To be sure, *Graham* recognized the need for "uniformity and definiteness." 383 U.S., at 18, 86 S. Ct. 684, 15 L. Ed. 2d 545. Yet the principles laid down in *Graham* reaffirmed the "functional approach" of *Hotchkiss*, 52 U.S. 248, 11 How. 248, 13 L. Ed. 683. See 383 U.S., at 12, 86 S. Ct. 684, 15 L. Ed. 2d 545. To this end, *Graham* set forth a broad inquiry and invited courts, where appropriate, to look at any secondary considerations that would prove instructive. *Id.*, at 17, 86 S. Ct. 684, 15 L. Ed. 2d 545.

Neither the enactment of § 103 nor the analysis in *Graham* disturbed this Court's earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art. For over a half century, [***33] the Court has held that [**LEdHR4] [4] a "patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men." *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 71 S. Ct. 127, 95 L. Ed. 162, 1951 Dec. Comm'r Pat. 572 (1950). This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. Three cases decided after *Graham* illustrate the application of this doctrine.

In *United States v. Adams*, 383 U.S. 39, 40, 86 S. Ct. 708, 15 L. Ed. 2d 572, 174 Ct. Cl. 1293 (1966), a companion case to *Graham*, the Court considered the obviousness of a "wet battery" that varied from [**721] prior designs in two ways: [*1740] It contained water, rather than the acids conventionally employed in storage batteries; and its electrodes were magnesium and cuprous chloride, rather than zinc and silver chloride. The Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one [***34] element for another known in the field, the combination must do more than yield a predict-

able result. 383 U.S., at 50-51, 86 S. Ct. 708, 15 L. Ed. 2d 572, 174 Ct. Cl. 1293 It nevertheless rejected the Government's claim that Adams's battery was obvious. The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.*, at 51-52, 86 S. Ct. 708, 15 L. Ed. 2d 572, 174 Ct. Cl. 1293 When Adams designed his battery, the prior art warned that risks were involved in using the types of electrodes he employed. The fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that Adams's design was not obvious to those skilled in the art.

In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 90 S. Ct. 305, 24 L. Ed. 2d 258 (1969), the Court elaborated on this approach. The subject matter of the patent before the Court was a device combining two pre-existing elements: a radiant-heat burner and a paving machine. The device, the Court concluded, did not create some new synergy: The radiant-heat burner functioned just as a burner was expected to function; and the paving machine did [***35] the same. The two in combination did no more than they would in separate, sequential operation. *Id.*, at 60-62, 90 S. Ct. 305, 24 L. Ed. 2d 258. In those circumstances, "while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented," and the patent failed under § 103. *Id.*, at 62, 90 S. Ct. 305, 24 L. Ed. 2d 258 (footnote omitted).

Finally, in *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 96 S. Ct. 1532, 47 L. Ed. 2d 784 (1976), the Court derived from the precedents the conclusion that when a patent "simply arranges old elements with each performing the same function it had been known to perform" and yields no more than one would expect from such an arrangement, the combination is obvious. *Id.*, at 282, 96 S. Ct. 1532, 47 L. Ed. 2d 784.

The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. [**LEdHR5] [5] When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For [***36] the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson's-Black Rock* are illustrative--a court must ask whether the improvement is more

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than the predictable use of prior art elements according to their established functions.

Following these principles may be [**722] more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement. Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having [*1741] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis [***37] should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ([**LEdHR6] [6] "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

B

When it first established the requirement of demonstrating a teaching, suggestion, or motivation to combine known elements in order to show that the combination is obvious, the Court of Customs and Patent Appeals captured a helpful insight. See *Application of Bergel*, 292 F.2d 955, 956-957, 48 C.C.P.A. 1102, 1961 Dec. Com-m'r Pat. 504 (1961). As is clear from cases such as *Adams*, [**LEdHR7] [7] a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation [***38] the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

Helpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the TSM test is incompatible with our precedents. [**LEdHR8] [8] The obviousness analysis cannot be

confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection [***39] to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.

In the years since the Court of Customs and Patent Appeals set forth the [**723] essence of the TSM test, the Court of Appeals no doubt has applied the test in accord with these principles in many cases. There is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis. But when a court transforms the general principle into a rigid rule that limits the obviousness inquiry, as the Court of Appeals did here, it errs.

C

The flaws in the analysis of the Court of Appeals relate for the most part to the court's narrow conception of the obviousness inquiry reflected in its application of the TSM test. [**LEdHR9] [9] In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the [*1742] patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103. One of the ways in which a patent's subject matter can be proved obvious is [***40] by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

The first error of the Court of Appeals in this case was to foreclose this reasoning by holding that courts and patent examiners should look only to the problem the patentee was trying to solve. *119 Fed. Appx.*, at 288. The Court of Appeals failed to recognize that [**LEdHR10] [10] the problem motivating the patentee may be only one of many addressed by the patent's subject matter. The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art. Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.

The second error of the Court of Appeals lay in its assumption that a person of ordinary skill attempting to

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solve a problem will be led only to those elements of prior art designed to solve the same problem. *Ibid.* The primary purpose of Asano was solving the constant ratio problem; so, the court concluded, [***41] an inventor considering how to put a sensor on an adjustable pedal would have no reason to consider putting it on the Asano pedal. *Ibid.* Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. Regardless of Asano's primary purpose, the design provided an obvious example of an adjustable pedal with a fixed pivot point; and the prior art was replete with patents indicating that a fixed pivot point was an ideal mount for a sensor. The idea that a designer hoping to make an adjustable electronic pedal would ignore Asano because Asano was designed to solve the constant ratio problem makes little sense. A person of ordinary skill is also a person of ordinary creativity, not an automaton.

The same constricted analysis led the Court of Appeals to conclude, in error, that a patent claim cannot be proved obvious merely by showing that the combination of elements was "obvious to try." *Id.*, at 289 (internal quotation marks omitted). [**LEdHR11] [11] When there is a design need or market pressure to solve a problem [***42] and there are a finite number of identified, predictable [**724] solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

The Court of Appeals, finally, drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias. [**LEdHR12] [12] A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36, 86 S. Ct. 684, 15 L. Ed. 2d 545 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "guard against slipping into the use of hindsight" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (CA6 1964))). Rigid preventative rules that deny factfinders recourse to common sense, however, are [*1743] neither necessary under our case law nor consistent with it.

We note the [***43] Court of Appeals has since elaborated a broader conception of the TSM test than was applied in the instant matter. See, e.g., *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (2006) ("Our suggestion test is

in actuality quite flexible and not only permits, but *requires*, consideration of common knowledge and common sense"); *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291 (2006) ("There is flexibility in our obviousness jurisprudence because a motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine . . ."). Those decisions, of course, are not now before us and do not correct the errors of law made by the Court of Appeals in this case. The extent to which they may describe an analysis more consistent with our earlier precedents and our decision here is a matter for the Court of Appeals to consider in its future cases. What we hold is that the fundamental misunderstandings identified above led the Court of Appeals in this case to apply a test inconsistent with our patent law decisions.

III

When we apply the standards we have [***44] explained to the instant facts, claim 4 must be found obvious. We agree with and adopt the District Court's recitation of the relevant prior art and its determination of the level of ordinary skill in the field. As did the District Court, we see little difference between the teachings of Asano and Smith and the adjustable electronic pedal disclosed in claim 4 of the Engelgau patent. A person having ordinary skill in the art could have combined Asano with a pedal position sensor in a fashion encompassed by claim 4, and would have seen the benefits of doing so.

A

Teleflex argues in passing that the Asano pedal cannot be combined with a sensor in the manner described by claim 4 because of the design of Asano's pivot mechanisms. See Brief for Respondents 48-49, and n 17. Therefore, Teleflex reasons, even if adding a sensor to Asano was obvious, that does not establish that claim 4 encompasses obvious subject matter. This argument was not, however, [**725] raised before the District Court. There Teleflex was content to assert only that the problem motivating the invention claimed by the Engelgau patent would not lead to the solution of combining of Asano with a sensor. See Teleflex's Response [***45] to KSR's Motion for Summary Judgment of Invalidity in No. 02-74586 (ED Mich.), pp 18-20, App. 144a-146a. It is also unclear whether the current argument was raised before the Court of Appeals, where Teleflex advanced the nonspecific, conclusory contention that combining Asano with a sensor would not satisfy the limitations of claim 4. See Brief for Plaintiffs-Appellants in No. 04-1152 (CA Fed.), pp 42-44. Teleflex's own expert declarations, moreover, do not support the point Teleflex now raises. See Declaration of Clark J. Radcliffe, Ph.D., Supplemental App. 204-207; Declaration of Timothy L. Andresen, *id.*, at 208-210. The only statement in either dec-

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laration that might bear on the argument is found in the Radcliffe declaration:

"Asano . . . and Rixon . . . are complex mechanical linkage-based devices that are expensive to produce and assemble and difficult to package. It is exactly these difficulties with prior art designs that [Engelgau] resolves. The use of an adjustable pedal with a single pivot reflecting pedal position combined with an electronic control mounted between the [*1744] support and the adjustment assembly at that pivot was a simple, elegant, and novel combination [***46] of features in the Engelgau'565 patent." *Id.*, at 206, P 16.

Read in the context of the declaration as a whole this is best interpreted to mean that Asano could not be used to solve "[t]he problem addressed by Engelgau'565[:] to provide a less expensive, more quickly assembled, and smaller package adjustable pedal assembly with electronic control." *Id.*, at 205, P 10.

The District Court found that combining Asano with a pivot-mounted pedal position sensor fell within the scope of claim 4. 298 F. Supp. 2d, at 592-593. Given the significance of that finding to the District Court's judgment, it is apparent that Teleflex would have made clearer challenges to it if it intended to preserve this claim. In light of Teleflex's failure to raise the argument in a clear fashion, and the silence of the Court of Appeals on the issue, we take the District Court's conclusion on the point to be correct.

B

The District Court was correct to conclude that, as of the time Engelgau designed the subject matter in claim 4, it was obvious to a person of ordinary skill to combine Asano with a pivot-mounted pedal position sensor. There then existed a marketplace that created a strong [***47] incentive to convert mechanical pedals to electronic pedals, and the prior art taught a number of methods for achieving this advance. The Court of Appeals considered the issue too narrowly by, in effect, asking whether a pedal designer writing on a blank slate would have chosen both Asano and a modular sensor similar to the ones used in the Chevrolet truckline and disclosed in the '068 patent. The District Court employed this narrow inquiry as well, though it reached the correct result nevertheless. The proper question to have asked was whether a pedal designer of ordinary skill, facing the wide range of needs created by developments in the field of endeavor,

[**726] would have seen a benefit to upgrading Asano with a sensor.

In automotive design, as in many other fields, the interaction of multiple components means that changing one component often requires the others to be modified as well. Technological developments made it clear that engines using computer-controlled throttles would become standard. As a result, designers might have decided to design new pedals from scratch; but they also would have had reason to make pre-existing pedals work with the new engines. Indeed, upgrading its [***48] own pre-existing model led KSR to design the pedal now accused of infringing the Engelgau patent.

For a designer starting with Asano, the question was where to attach the sensor. The consequent legal question, then, is whether a pedal designer of ordinary skill starting with Asano would have found it obvious to put the sensor on a fixed pivot point. The prior art discussed above leads us to the conclusion that attaching the sensor where both KSR and Engelgau put it would have been obvious to a person of ordinary skill.

The '936 patent taught the utility of putting the sensor on the pedal device, not in the engine. Smith, in turn, explained to put the sensor not on the pedal's footpad but instead on its support structure. And from the known wire-chafing problems of Rixon, and Smith's teaching that "the pedal assemblies must not precipitate any motion in the connecting wires," Smith, col. 1, lines 35-37, Supplemental App. 274, the designer would know to place the sensor on a nonmoving part of the pedal structure. The most obvious nonmoving point on the structure from which a sensor can [*1745] easily detect the pedal's position is a pivot point. The designer, accordingly, would follow Smith [***49] in mounting the sensor on a pivot, thereby designing an adjustable electronic pedal covered by claim 4.

Just as it was possible to begin with the objective to upgrade Asano to work with a computer-controlled throttle, so too was it possible to take an adjustable electronic pedal like Rixon and seek an improvement that would avoid the wire-chafing problem. Following similar steps to those just explained, a designer would learn from Smith to avoid sensor movement and would come, thereby, to Asano because Asano disclosed an adjustable pedal with a fixed pivot.

Teleflex indirectly argues that the prior art taught away from attaching a sensor to Asano because Asano in its view is bulky, complex, and expensive. The only evidence Teleflex marshals in support of this argument, however, is the Radcliffe declaration, which merely indicates that Asano would not have solved Engelgau's goal of making a small, simple, and inexpensive pedal. What the declaration does not indicate is that Asano was

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somehow so flawed that there was no reason to upgrade it, or pedals like it, to be compatible with modern engines. Indeed, Teleflex's own declarations refute this conclusion. Dr. Radcliffe states that [***50] Rixon suffered from the same bulk and complexity as did Asano. See *id.*, at 206. Teleflex's other expert, however, explained that Rixon was itself designed by adding a sensor to a pre-existing mechanical pedal. See *id.*, at 209. If Rixon's base pedal was not too flawed to upgrade, then Dr. Radcliffe's declaration does not show Asano was either. Teleflex may have made a plausible argument that Asano is inefficient as compared [**727] to Engelgau's preferred embodiment, but to judge Asano against Engelgau would be to engage in the very hindsight bias Teleflex rightly urges must be avoided. Accordingly, Teleflex has not shown anything in the prior art that taught away from the use of Asano.

Like the District Court, finally, we conclude Teleflex has shown no secondary factors to dislodge the determination that claim 4 is obvious. Proper application of *Graham* and our other precedents to these facts therefore leads to the conclusion that claim 4 encompassed obvious subject matter. As a result, the claim fails to meet the requirement of § 103.

We need not reach the question whether the failure to disclose Asano during the prosecution of Engelgau voids the presumption of validity given [***51] to issued patents, for claim 4 is obvious despite the presumption. We nevertheless think it appropriate to note that the rationale underlying the presumption--that the PTO, in its expertise, has approved the claim--seems much diminished here.

IV

A separate ground the Court of Appeals gave for reversing the order for summary judgment was the existence of a dispute over an issue of material fact. We disagree with the Court of Appeals on this point as well. To the extent the court understood the *Graham* approach to exclude the possibility of summary judgment when an expert provides a conclusory affidavit addressing the question of obviousness, it misunderstood the role expert testimony plays in the analysis. [**LEdHR13] [13] In considering summary judgment on that question the district court can and should take into account expert testimony, which may resolve or keep open certain questions of fact. That is not the end of the issue, however. The ultimate judgment of obviousness is a legal determination. *Graham*, 383 U.S., at 17, 86 S. Ct. 684, 15 L. Ed. 2d 545. Where, as here, the content of the prior art, the scope of the patent [*1746] claim, and the level of ordinary skill in the art are not in material dispute, and

[***52] the obviousness of the claim is apparent in light of these factors, summary judgment is appropriate. Nothing in the declarations proffered by Teleflex prevented the District Court from reaching the careful conclusions underlying its order for summary judgment in this case.

* * *

We build and create by bringing to the tangible and palpable reality around us new works based on instinct, simple logic, ordinary inferences, extraordinary ideas, and sometimes even genius. These advances, once part of our shared knowledge, define a new threshold from which innovation starts once more. And [**LEdHR14] [14] as progress beginning from higher levels of achievement is expected in the normal course, the results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See *U.S. Const.*, Art. I, § 8, cl. 8. These premises led to the bar on patents claiming obvious subject matter established in *Hotchkiss* and codified in § 103. Application of the bar must not be confined within a test or formulation too constrained to serve its purpose.

KSR provided convincing evidence that mounting a modular [***53] sensor on a fixed pivot point of the Asano pedal was a design step well within the [**728] grasp of a person of ordinary skill in the relevant art. Its arguments, and the record, demonstrate that claim 4 of the Engelgau patent is obvious. In rejecting the District Court's rulings, the Court of Appeals analyzed the issue in a narrow, rigid manner inconsistent with § 103 and our precedents. The judgment of the Court of Appeals is reversed, and the case remanded for further proceedings consistent with this opinion.

It is so ordered.

REFERENCES

35 U.S.C.S. § 103

Chisum on Patents §§ 5.02-5.04, 11.06 (Matthew Bender)

L Ed Digest, Patents § 19.1

L Ed Index, Patents

Supreme Court's views as to what is patentable subject matter under federal law as "process," "machine," "manufacture," or "composition of matter." 65 L. Ed. 2d 1197.